

Reply to Office Action
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Customer No.: 33354

REMARKS

A. Status of Claims

Claims 1-5, 7-9, and 24-27 are pending and claims 1, 5, 8, and 9 are amended as described herein. Claims 10-15 and 21-23 have been withdrawn from consideration. Claims 24-27 are new. Claims 6 and 16-20 are cancelled.

B. Amendments to the Specification

Applicant has amended paragraph 0022 to correct a typographical error.

C. Objection to the Drawings

The Examiner has objected to the drawings citing that the "at least one non-approving facial indicium" and the "at least one smiling indicium" as claimed in claims 5 and 6 are not shown in the drawings. Applicant has carefully reviewed the drawings and respectfully points out to the Examiner that these features are shown in the figures. Specifically, the "at least one non-approving facial indicium" is shown in figure 3 (108) and the "at least one smiling indicium" is shown in figure 2 (106). Applicant has verified through private PAIR that the office did receive figures 2 and 3 with the application as filed. Therefore, the Examiner is respectfully requested to withdraw his objection to the drawings.

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D. Objection to the Specification

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner argues that the specification fails to indicate that the "at least one reference marker" can include a smiling face and a non-approving facial indicium as defined in claim 5.

Applicant has reviewed the specification and directs the Examiner's attention to paragraphs 0017 and 0020. Paragraph 0017 states that the reference marker can include one or more smiling indicia such as a smiley face. Paragraph 0020 states that the reference marker can include non-approving facial indicia.

In view of paragraphs 0017 and 0020, Applicant believes that the specification does provide proper antecedent basis for the claimed subject matter. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to the specification.

E. Claim Objections

The Examiner has objected to claim 8 due to informalities. Claim 8 has been amended to correct these informalities and the Examiner is respectfully requested to withdraw his objection to claim 8.

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F. §112 Rejections

The Examiner has rejected claims 1-9 and 20 under 35 USC §112 (2nd Paragraph). With respect to claim 1, the Examiner asserts that the limitations of "at least one reference marker" and "at least one display" are confusing because it is not clear whether Applicant is referring to the "at least one reference marker" and the "at least one display" defined earlier in the claim. Therefore, it appears that the Examiner is rejecting these claims for lack of antecedent basis with respect to these elements. Applicant respectfully reminds the Examiner that the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. *MPEP §2173.05(e)*. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Id.* citing *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). In *Porter*, the Board noted that the claim was not indefinite as argued by the Examiner because the format of the rejected claim had been acceptable for years. *Id.*

In claim 1, the phrases "at least one reference marker" and "at least one display" are only preceded by identical phrases once, and Applicant believes that one of ordinary skill in the art would easily be able to ascertain the scope of the claim without Applicant needing to amend the claims to insert the words "the" or "said" before the second occurrences of these phrases. In fact, Applicant believes that adding the term "the" or "said" to the claims would render the claims verbose and difficult to understand. Moreover, there are several issued patents that do not insert the terms "the" or "said" before the phrase "at least one" (see U.S. Patent 5,564,823 for example) and this format therefore has been accepted

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before by the Office. Therefore, this rejection under 35 USC §112 (2nd Paragraph) is improper and the Examiner is respectfully requested to withdraw it with respect to claim 1 and any other claims rejected as being indefinite for this reason.

The Examiner has rejected claim 5 by asserting that it is not clear how the "at least one reference" marker can include both a smiling face and a non-approving facial indicium. Applicant has amended claim 5 to enable it to depend from claim 2 instead of claim 4 to clarify claim 5. Applicant believes that this amendment addresses the rejection of claim 5 and the Examiner is asked to withdraw it.

With respect to claim 9, the Examiner has rejected that claim for improper use of a trademark within the claim. Claim 9 has been amended to delete the trademark. Finally, claims 6 and 20 have been cancelled and the rejection of these claims is now moot.

G. § 102 Rejections Citing Jackson

Claims 1, 8, 9, 16, 19, and 20 are currently rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,464,672 to Jackson (Jackson). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051 at 1053 (Fed. Cir.1987).

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Jackson does not disclose a display with a reference marker that is only located on a non-contoured edge of the notepad. Rather, Jackson discloses a notepad with a contoured edge that is the reference marker itself. Independent claim 1 and has been amended to recite that the reference marker is only located only a non-contoured edge of the display. No new matter is added by this amendment because this feature of the present invention is shown in figure 2 and described in paragraph 0017 of the specification as filed.

Because Jackson does not expressly or inherently disclose this claimed feature of Applicant's invention, Jackson does not anticipate claim 1 and the Examiner is respectfully requested to withdraw this rejection. The Examiner is also requested to withdraw his rejections of dependent claims 8 and 9 due to their dependency on allowable base claims. Claims 16, 19, and 20 have been cancelled and the rejection of these claims is now moot.

H. § 102 Rejections Citing Sabella

Claims 1, 8, 9, 16, 19, and 20 are currently rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,703,096 to Sabella (Sabella). Again, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Id.*

Sabella also does not disclose a display with a reference marker that is only located on a non-contoured edge of the display. As shown in figure 3, Sabella discloses that the reference marker is on multiple surfaces and edges of the notepad. Placing reference markers on multiple surfaces and edges of the

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notepad defeats the purpose of the present invention because multiple reference markers would indicate multiple proper orientations. However, for a notepad, there is only one proper orientation and therefore there can only be one reference marker. Multiple reference markers are analogous to multiple road signs to get to a desired location, each with an arrow pointing a different direction.

As discussed above, independent claim 1 has been amended to recite that the reference marker is only on one edge of the display or notepad, namely the non-contoured edge that is not bound. As such, Sabella also fails to expressly or inherently disclose every element in claim 1 and does not anticipate claim 1 and the Examiner is respectfully requested to withdraw this rejection. The Examiner is also requested to withdraw the rejections of dependent claims 8 and 9 based on their dependency to allowable base claims. Claims 16, 19, 19 and 20 are cancelled and the rejection of these claims is moot.

I. § 103 Rejections Citing Jackson

Claims 2-7, are currently rejected under 35 USC §103(a) as being obvious in view of Jackson. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143.

As discussed above, independent claim 1 from which these claims depend from has been amended to recite a display with a reference marker located on the non-contoured edge of the display. This feature is neither taught nor

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suggested by Jackson and therefore claims 2-7 are not obvious in view of Jackson. Applicant respectfully requests that the Examiner withdraw these rejections. Claims 17 and 18 have been cancelled and the rejection of these claims is now moot.

J. § 103 Rejections Citing Sabella

Claims 2-7 are currently rejected under 35 USC §103(a) as being obvious in view of Sabella. Again, a claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *Id.*

As discussed above, independent claim 1 from which these claims depend from has been amended to recite that the reference marker is only on one edge of the display, namely the non-contoured edge. This feature is neither taught nor suggested by Sabella and therefore claims 2-7 are not obvious in view of Sabella. Moreover, since Sabella places reference markers on multiple edges and surfaces of the notepad, it actually teaches away from Applicant's invention. Applicant respectfully requests that the Examiner withdraw these rejections as well. Claims 17 and 18 have been cancelled and the rejection of these claims is now moot.

K. New Claims 24-27

Applicant has added claims 24-27 to more clearly recite what he regards as his invention. Newly added claims 24-27 are similar to the pending claims

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except that they limit the display to a notepad and they more clearly define the structural elements of a notepad utilizing Applicant's invention. No new matter is added by these claims because Applicant's invention applied to a notepad is shown in figures 1-3 and discussed in paragraphs 0016, 0019, and 0020 of the specification as filed.

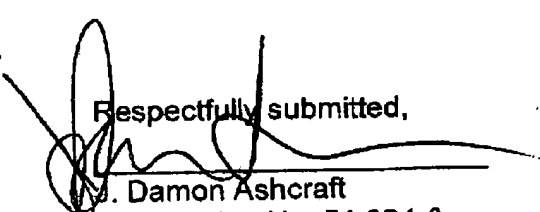
Newly added claims 24-27 are also believed to be allowable over the prior art of record. Specifically, claims 24-27 more distinctly define Applicant's invention as claimed in amended claims 1-5 and 7-9 that are believed to be allowable. Therefore, these new narrower claims should also be allowable and the Examiner is respectfully requested to allow them as well.

CONCLUSION

Applicants respectfully submit that all rejections have been addressed. Applicants respectfully request that the Examiner allow the application to proceed to allowance. If the Examiner has any questions or suggestions to place the application in even a better condition for allowance, he is requested to call Damon Ashcraft at 602-681-3331.

2/22/06
Dated

Respectfully submitted,


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